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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/608,862  | 06/27/2003  | M. Bret Schneider    | Telecath              | 8207             |
| 42293   | 7590        | 03/08/2007           | EXAMINER              |                  |
| DEANNA J. SHIRLEY<br>3418 BALDWIN WAY<br>SANTA ROSA, CA 95403 |             |                      | KOHARSKI, CHRISTOPHER |                  |
|   |             | ART UNIT             | PAPER NUMBER          |                  |
|   |             | 3763                 |                       |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE                        | MAIL DATE   | DELIVERY MODE        |                       |                  |
| 3 MONTHS  | 03/08/2007  | PAPER                |                       |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                         |                     |
|------------------------------|-------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>  | <b>Applicant(s)</b> |
|                              | 10/608,862              | SCHNEIDER ET AL.    |
|                              | <b>Examiner</b>         | <b>Art Unit</b>     |
|                              | Christopher D. Koharski | 3763                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 03 January 2007.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-6,8-13 and 16-22 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6,8-13 and 16-22 is/are rejected.
- 7) Claim(s) 16-17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges the reply filed 1/03/2007 in which claims 1, 8 and 16 were amended, claims 21-22 were added and claims 7 and 14-15 were cancelled. Currently claims 1-6, 8-13, and 16-22 are pending for examination in this application.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-6 and 8-13 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

Examiner notes that no separate arguments were present in the response regarding claims 16-20 and therefore in light of Applicant's amendments to these claims, Examiner does not find the amendments compelling to overcome the reference. The prior art of record teaches all elements as claimed and these elements satisfy all structural, functional, operational, and spatial limitations currently in the claims. Therefore the standing rejections are proper and maintained.

### ***Claim Objections***

Claims 16-17 is objected to because of the following informalities: Regarding claim 16, "... a drum coupled to two *elongate member* where a first..." contains a grammatical error. Regarding claim 17, it is unclear to which "elongate member" is being advanced (the first or second?). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 8-9 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ein-Gal (6,517,537). Ein-Gal discloses an electrosurgical system.

Regarding claims 1-2, 8-9 and 13, Ein-Gal discloses an apparatus and method of manipulating multiple elongate members (12, 14) with a base unit (22) wherein upon receiving input from a user the apparatus (10) (Figure 1A) is directed to manipulate several elongate flexible and rigid elements (needles and sheaths) to retract and advance (Figure 4) and in addition sending signals to motor drive means (40) to rotate

the base about the axis on the elongate member upon the axis of the elongate member (Figures 3-4) (col 4, ln 45-60).

***Claim Rejections - 35 USC § 102***

Claims 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Beyar (6,726,675). Beyar discloses a remote control catheterization system.

Regarding claims 16-20, Beyar discloses an apparatus that comprises a base coupled to several elongate members (26, 46, 48) with a first (60) and second (61) motor coupled to the base (Figures 2-3) to retract and rotate the elongate member wherein the drive mechanism consists of several *coupled* rotatable drum/wheel combinations that rotate around in a perpendicular axis to the elongate members and are coupled (Figure 3) to the elongate members (Figure 2). Additionally, Beyar discloses a elongate members that consists of a cannula, catheter, and guidewire (26, 46, 48) that are inherently flexible to be put into the vasculature of the patient being controlled by a pointing device (40) with proportional speed control (col 6, ln 20-30) coupled to a computer (34) system wherein the system rotates a series of motors to maneuver the catheter remotely. The motor drive includes several biasing wheels (Figures 2-3) and a clip wheel (63,67) to retain the different members.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-6 and 10-12 are rejected under 35 U.S.C 103(a) as being unpatentable over Ein-Gal in view of Beyar. Ein-Gal meets the claim limitations as described above except for specific wheel rotation and pointing computer device control.

However, Beyar discloses a remote control catheterization system.

Regarding claims 4-6 and 10-12, Beyar discloses a elongate members that consists of a cannula, catheter, and guidewire (26, 46, 48) that are inherently flexible to be put into the vasculature of the patient being controlled by a pointing device (40) with proportional speed control (col 6, ln 20-30) coupled to a computer (34) system wherein the system rotates a series of motors to maneuver the catheter remotely.

At the time of the invention, it would have been obvious to add the computer drive system of Beyar to the system of Ein-Gal in order to easily accommodate user control and effectively control the electrosurgical system. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Beyar.

***Claim Rejections - 35 USC § 103***

Claims 21-22 are rejected under 35 U.S.C 103(a) as being unpatentable over Ein-Gal in view of Brock et al. (2002/0095175). Ein-Gal meets the claim limitations as described above except for specific mention of fine resolution control.

However, Brock et al. teaches a flexible instrument controller.

Regarding claims 21-22, Brock et al. teaches a computer system that allows for more precise control over a remotely controlled medical tool with the aide of a computer system (abstract, Figures 1-6).

At the time of the invention, it would have been obvious to add the algorithms and computer programming of Brock et al. to the system of Ein-Gal to promote accurate and precise medical intervention. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Brock et al.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 2/27/01



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